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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,494	11/19/2001	Alex P. Weaver	WEAVER.PT1	5181
24943	7590	12/04/2006	EXAMINER	
INTELLECTUAL PROPERTY LAW GROUP LLP			GARCIA, ERNESTO	
12 SOUTH FIRST STREET			ART UNIT	
SUITE 1205			PAPER NUMBER	
SAN JOSE, CA 95113			3679	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09/997,494

EXAMINER

ART UNIT

PAPER

20061117

DATE MAILED:

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**Commissioner for Patents**

See Attachment

***Response to Amendment***

DPS The reply filed on September 27, 2006 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The amendment has not been made relative to the prior version of record that has been entered on May 5, 2005. Note that none of the amendments <sup>filed</sup>~~filed~~ subsequent to May 5, 2005 have been entered since the amendments have not complied with 37 CFR 1.121. The current changes are to be made relative to the May 5, 2005 submission and not the last non-entered amendment.

With respect to the arguments, note that by original presentation, see original filed claims, the claims were directed to a "mortise joint", the subcombination, and not to "a plurality of four double locking mortise joints and a tabletop", a combination. Applicant cannot shift inventions during prosecution on the merits of the application. Applicant needs to present claims to a double locking mortise joint and not to the combination because claims 21-23 and 27 appear to be directed to a table as the combination of four joints and a tabletop inherently make up a table as described and not to "a mortise joint" as originally claimed. How does presenting claims only to a combination, which was not originally filed or presented, constitute not switching inventions? Applicants argue that the combination requires the elements of the double locking mortise.

Art Unit: 3679

DPS This argument is not persuasive because applicants are no longer claiming the subcombination and thus there is no subcombination present to compare to the <sup>now</sup> ~~new~~ <sup>applicants</sup> and newly presented combination. Thus, it is evident that <sup>applicant</sup> ~~applicant~~ have entirely shifted what they consider to be their invention from merely the originally claimed "joint" to a table combination having four joints. This shift is improper and not permitted. If applicants have not shifted their claimed invention, then which remaining claim of record recites only the joint subcombination? Further, is it <sup>applicants'</sup> ~~applicant's~~ position that the examiner need only meet the limitations of the joint subcombination since the originally presented and claimed invention has "not" changed? Nevertheless, <sup>applicants'</sup> ~~applicant's~~ actions would appear to evidence that patentability is no longer considered to be in the joint, itself, but rather in where and how the joint is used, i.e., the combination. Moreover, a comparison with the last presented subcombination claim (claim 1) reveals that newly presented claim 21 to the combination fails to include all the particulars of the previously claimed subcombination and thus the combination of now presented claim 21 would be independent and distinct from the subcombination of the now intended to be cancelled claim 1.

Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-282-7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large, looping initial "D".

E.G.

November 28, 2006